

REMARKS

Pursuant to entry of this amendment, claims 1-4 and 7-20 are pending in the application. Claims 14-20 stand withdrawn.

Claim Rejections – 35 U.S.C. §103

Claims 1-4 and 7-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nakajima et al. (WO 01/02316 with translation U.S. Patent No. 6,863,956)
Applicant respectfully traverses.

CLAIM 1

Independent claim 1 recites a disk-shaped object which, among other things, includes a central hole. Nakajima does not disclose a disk-shaped object including a central hole, but does assert that it would have been obvious to modify Nakajima to include a central hole. The Office Action provides two rationales as to why it would have been obvious to modify Nakajima to meet claim 1: (1) it would have been an obvious matter of design choice; and (2) one of ordinary skill in the art would have been motivated to change shape in order to adapt the adhesive to different surfaces. (*see* paragraphs 5 and 6 of the Office Action). As explained below, Applicant disagrees with the Office Action's rationales and explanation of the law.

(1) Design Choice/Change in Size or Shape

Citing MPEP §2144.04 (I) and (IV), the Office Action states that “A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results.” Applicant can find no such explanation of the law in the

cited sections of the MPEP, which are discussed individually in further detail below.

Furthermore, the addition of a hole does provide an unexpected result.

a) MPEP 2144.04(I) - Aesthetic Design Changes

MPEP §2144.04 (I) is directed to aesthetic design changes. The MPEP cites a case in which “[t]he court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.” (*see In re Seid*, MPEP 2144.04 (I)). As a counterpoint, the MPEP cites *Ex Parte Hilton*, which held that the shape of the invented potato chips were important when considered against the prior art French fries. (*see* MPEP 2144.04 (I)). Thus, the court has held only that mere ornamentation without any mechanical function cannot be relied upon to patentably distinguish a claimed invention.

Unlike the *In re Seid* case, in the present case, the claimed central hole is not a mere ornamentation without mechanical function. Instead, as seen in the exemplary embodiment of the present application, the hole is a functional feature which allows the object 1 to serve as an intermediate between structural parts. Therefore, a central hole would not serve an ornamental function either in the prior art or in the embodiments of the present application.

In view of the above, MPEP 2144.04(I) does not provide a rationale for holding the claimed invention obvious in the present case.

b) MPEP 2144.04(IV) A and B – Changes in Size and Shape

MPEP §2144.04(IV) is specifically directed to changes in size and shape with section (A). directed to size and section (B). directed to shape.

As noted above, one difference between the claimed invention and Nakajima is the recitation of a central hole in claim 1. Since Nakajima lacks a central hole, claim 1 is not a "mere scaling up of a prior art process". Scaling up would change the size, not add a central hole. Accordingly, MPEP §2144.04(IV)(A), relating to a change in size, and the cases cited therein, is inapplicable.

MPEP §2144.04(IV)(B), citing *in re Dailey* is directed to circumstances in which a change in shape could be considered obvious. However, the requirements outlined in this section of the MPEP and the facts of *in re Dailey* are also inapplicable to the present case. *In re Dailey* is directed to a case in which a claimed configuration was not significant. In this case, the presence of a central hole is significant. As shown in the exemplary embodiment of the present application, the object 1 is used as an intermediate between structural parts (*i.e.*, the plate 20 and the flange 21 of the fastening element 22). The object 1 could not be used as an intermediary with the parts of the exemplary embodiment without the hole. The hole is a significant feature which allows the part to be used as shown in the exemplary embodiment of the present application.

Additionally, the claimed invention does provide an unexpected result. Nakajima is directed to an interlayer for laminated glass. The present application teaches an exemplary embodiment in which by using a hole, among other things, the object can be used as an intermediary between a flange of a fastening element and a plate-member in order to provide a seal. It is clearly unexpected that adding a hole to a part designed to keep glass together would result in such a part being useful as an intermediary between a fastening member and a plate.

(2) Motivation to Change Shape

The Examiner's second rationale for modifying Nakajima is that "one of ordinary skill in the art would have been motivated to change shape in order [to] adapt the adhesive to different surfaces." The Examiner cites several US patents as evidence that "adhesives can be made into disk shapes to suit different user needs".

First, Applicant notes that the Examiner rejects claim 1 based on Nakajima alone. The remaining US patents are not made part of the rejection. Indeed, US Patent Nos. 6,503,357 and 4,805,541 are only mentioned in the "Answers to Applicant's Arguments" section and are first mentioned only in this final rejection. The Examiner only indicates that they are evidence that adhesives can be made into different shapes.

Applicant agrees that adhesives can be made into different shapes. However, that something is possible, does not make it obvious. Nakajima is directed to laminated glass for use in windows of automobiles, aircraft, and buildings. (*see* column 1, lines 15-16). Applicant disagrees that it would have been obvious to make an adhesive for laminated glass for windows in aircraft, buildings or automobile with a central hole. Indeed, the inclusion of a central hole in an adhesive for use in an aircraft, automobile or building window would be counterproductive. It would leave a central part of these generally rectangular windows without an interlayer. Accordingly, Applicant submits that it would not have been obvious to modify the Nakajima adhesive to include a central hole at least because it would be detrimental to the intended purpose of the adhesive.

(3) Allowability of Claim 1 and its Dependents

For the reasons discussed above Applicant submits that it would not have been obvious to modify Nakajima to meet the claimed invention. Accordingly, Applicant submits that claim 1 is allowable over Nakajima. Claims 2-4 and 11 depend from claim 1 and are allowable at least by virtue of their dependency.

CLAIM 8

The present application teaches that when contact surfaces provided on opposite sides of a disk-shaped object of synthetic thermoplastic material are made rough, the objects can be separated without parting agents. Independent claim 8 recites a disk-shaped object wherein adhesive contact surfaces that entirely cover opposite sides of the single layer are rough and have an averaged roughness depth R_z of 40-100 μ and an arithmetic mean rugosity R_a of from 6 to 25 μ .

The Examiner asserts that Nakajima discloses the claimed averaged roughness depth, but simply asserts that the arithmetic mean rugosity would be obvious. There is no indication that the Nakajima teaches the combination of an averaged roughness depth and arithmetic mean rugosity on contact surfaces that entirely cover opposite sides of a single layer. Nothing in Nakajima appears to be directed to the combination of averaged roughness depth and arithmetic mean rugosity as claimed.

The Examiner states that "It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results". However, "only

result-effective variables can be optimized.” (MPEP 2144.04 II B.). Nakajima does not discuss the combination of an averaged roughness depth and arithmetic mean rugosity on a contact surface that entirely covers opposite sides of a single layer as being a result-effective variable. Accordingly, it would not have been obvious to modify Nakajima as claimed.

MPEP 2144.04 does discuss unexpected results, but only in the context of overcoming a *prima facie* case of obviousness. However, the Examiner must first establish a *prima facie* case of obviousness. In this case, no *prima facie* case has been made.

In view of the above, Applicant submits that claim 8 is allowable over Nakajima and claims 9-11 are allowable at least by virtue of their dependency therefrom.

Conclusion

Applicants do not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, Applicants have not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application.

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Serial No. : 10/779,771
Filed : February 18, 2004
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Attorney Docket No. GER 8836

The USPTO is also authorized all required fees, except for the Issue Fee and the Publication Fee, to said Deposit Account No. 02-2550. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

Date: December 18, 2008



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